



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,033	02/14/2001	Michael V. Conant	DCRT001/01US	8233

22903 7590 11/17/2004

COOLEY GODWARD LLP  
ATTN: PATENT GROUP  
11951 FREEDOM DRIVE, SUITE 1700  
ONE FREEDOM SQUARE- RESTON TOWN CENTER  
RESTON, VA 20190-5061

EXAMINER

CAMPBELL, JOSHUA D

ART UNIT	PAPER NUMBER
----------	--------------

2179

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/782,033	Applicant(s) CONANT ET AL.	
	Examiner Joshua D Campbell	Art Unit 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 5-10 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: Response to Election/Restriction filed on 04/15/2004.
2. Claims 1-4 are pending in this case. Claims 1 and 2 are independent claims. Claims 1-4 have been elected based on the restriction. Due to the election claims 5-10 are no longer being considered in this application.

### ***Election/Restrictions***

3. Applicant's election without traverse of claims 1-4 in the reply filed on 04/15/2004 is acknowledged.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoyt et al. (IDS, hereinafter Hoyt, US Patent Number 6,067,531, issued on May 23, 2000) in view of Muranaga et al. (hereinafter Muranaga, US Patent Number 5,671,428, issued on September 23, 1997).

**Regarding independent claim 1,** Hoyt discloses a method in which a database of document template content (i.e. standard contract clauses) exists (column 2, lines 13-56 of Hoyt). Commands are received from a user in a multi-user environment to create a document for negotiating (i.e. contract) in which the commands designate the selection of content from the database, then associated the content with the document (Abstract and column 2, lines 13-56 of Hoyt). The document is then provided to another user in the environment (column 32, lines 13-60 of Hoyt). Hoyt does not disclose a method in which proposed amendments to the document are received and used to create a revision history associated with the document, or that the original user may also add proposed amendments to the revision history as a supplement to its creation. However, Muranaga discloses a method in which proposed edits are obtained from the second user at which point a revision history is created based on the amendments (lines 45-column 8, line 37 of Muranaga). Any other user within the environment (including the first user) may also make proposed amendments to the document that will also be added to the revision history (column 7, lines 45-column 8, line 37 of

Art Unit: 2179

Muranaga). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Hoyt with the methods of Muranaga because it would have allowed all proposed amendments to be viewed by all involved parties.

**Regarding independent claim 2**, Hoyt discloses a method in which a database of document template content (i.e. standard contract clauses) exists (column 2, lines 13-56 of Hoyt). Commands are received from a user in a multi-user environment to create a document for negotiating (i.e. contract) in which the commands designate the selection of content from the database, then associated the content with the document (Abstract and column 2, lines 13-56 of Hoyt). Hoyt does not disclose a method in which a custom database is created for each contract. However, Muranaga discloses a method in which each document gets a document database to store all the information corresponding to that particular document (column 11, lines 6-21 of Muranaga). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Hoyt with the methods of Muranaga because it would have provided a higher level of organization on a document-by-document basis.

**Regarding dependent claim 3**, Hoyt discloses a method in which a database of document template content (i.e. standard contract clauses) exists (column 2, lines 13-56 of Hoyt). Commands are received from a user in a multi-user environment to create a document for negotiating (i.e. contract) based on a template in which the commands designate the selection of content from the database, then associated the content with

the document (Abstract and column 2, lines 13-56 of Hoyt). The document is then provided to another user in the environment (column 32, lines 13-60 of Hoyt).

**Regarding dependent claim 4**, Hoyt does not disclose a method in which proposed amendments to the document are received and used to create a revision history associated with the document, or that the original user may also add proposed amendments to the revision history as a supplement to its creation. However, Muranaga discloses a method in which proposed edits are obtained from the second user at which point a revision history is created based on the amendments (lines 45-column 8, line 37 of Muranaga). Any other user within the environment (including the first user) may also make proposed amendments to the document that will also be added to the revision history (column 7, lines 45-column 8, line 37 of Muranaga). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Hoyt with the methods of Muranaga because it would have allowed all proposed amendments to be viewed by all involved parties.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent Number 5,515,491

US Patent Number 6,029,195

US Patent Number 6,144,991

US Patent Number 6,687,878

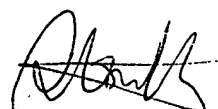
US Patent Application Publication Number 2002/0010686

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDC  
November 2, 2004



STEPHEN S. HONG  
PRIMARY EXAMINER